

REMARKS

In response to the above-identified Office Action, Applicants seek consideration of the following remarks. In this Office Action, Applicants do not amend, cancel, or add any claims. Accordingly, claims 1 and 4-5 are pending in this Application.

I. Claims Rejected Under 35 U.S.C. § 102

The Examiner rejects claims 1, 4, and 5 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,186,903 issued to Beebe et al. ("the '903 patent"). Applicants respectfully traverse the rejection.

To anticipate a claim, the cited reference must disclose every element of the rejected claim. Among other elements, claim 1 defines a golf club head comprising an "interior wall being integrally formed on said bottom surface of said primary cavity and extending from said bottom surface of said primary cavity in a direction that is substantially perpendicular to the longitudinal axis of said hosel thereby forming an included acute angle between said interior wall and said bottom surface of said cavity." Applicants submit the '903 patent fails to teach at least these elements of claim 1.

In making the rejection, the Examiner characterizes the '903 patent as disclosing every element of claim 1. Specifically, the Examiner points to Figures 1-9 and Columns 2-3 of the '903 patent as showing an "interior wall being integrally formed on said bottom surface of said primary cavity and extending from said bottom surface of said primary cavity in a direction that is substantially perpendicular to the longitudinal axis of said hosel thereby forming an included

acute angle between said interior wall and said bottom surface of said cavity.” Applicants respectfully disagree with the Examiner’s characterization of the ‘903 patent.

Notably, in the Office Action mailed July 23, 2004, the Examiner rejected claim 1 citing the corresponding United Kingdom patent (GB 2,351,447) to the ‘903 patent. Applicants responded to the rejection stating, “In the Beebe et al. reference, the interior wall 56 extends in a direction that forms and included right angle between the interior wall 56 and the bottom surface 54 of the primary cavity 26,” whereas claim 1 recites an interior wall extending from a bottom surface of the primary cavity in a direction that is substantially perpendicular to the longitudinal axis of the hosel to form an acute angle (See Applicants’ Response to Office Action mailed October 6, 2004 (citing Fig. 8 of GB 2,351,447), emphasis in original). The Examiner withdrew the rejection of claim 1 based on GB 2,351,447 in the next Office Action. Therefore, Applicants reiterate their earlier arguments that the ‘903 patent teaches a right angle whereas claim 1 recites an acute angle. Therefore, the ‘903 patent fails to disclose all of the elements of claim 1.

In the telephone conference between Applicants and the Examiner, the Examiner stated 1) that Applicants disclosure fails to support such an acute angle, and 2) that the Examiner would issue an obviousness rejection under 35 U.S.C. § 103 rejection by modifying the ‘903 patent since, by a design choice, the ‘903 patent could be modified to include an acute angle as opposed to a right angle. To both of these allegations, Applicants vehemently traverse.

With respect to the accusation that Applicants’ disclosure fails to support the inclusion of an acute angle, Applicants direct the Examiner’s attention to Applicants’ Figs. 8-10 reproduced below in Appendix A. These figures clearly show a longitudinal hosel axis “A” forming a right angle with direction “D” (See also Applicants’ disclosure pages 4, last sentence). Furthermore,

Applicants' disclosure states, "The interior wall 46 extends from the bottom surface 44 of the primary cavity 26 in a direction D (Fig. 9) that is substantially perpendicular to the longitudinal axis A of the hosel. Applicants submit that the disclosure of an acute angle is inherent in this disclosure since any loft included in the iron club head will create such an acute angle. Notably, Applicants' disclosure recites that Applicants disclosure is applicable to any iron from a one-iron to a wedge. One of ordinary skill in the art knows that each of these irons includes a face angle in the range of about 15 degrees to about 70 degrees. Therefore, the angle formed by the loft of the golf club would be less than 90 degrees (i.e., an acute angle) (See Appendix A, wherein the angle θ is always less than 90 degrees because of the loft of the golf club head). Thus, Applicants disclosure of an "interior wall 46 extends from the bottom surface 44 of the primary cavity 26 in a direction D (Fig. 9) that is substantially perpendicular to the longitudinal axis A of the hosel" clearly supports a recitation of an acute angle in claim 1.

With respect to the Examiner's allegation that a design choice to the '903 patent would render claim 1 obvious, Applicants submit that having the interior wall extend perpendicular to the hosel axis as recited in claim 1 allows the center of gravity of the golf club to be lower than the center of gravity of the golf club in the '903 patent. In other words, the design of the golf club in the '903 patent limits the ability to lower the center of gravity of the golf club. In contrast, by having the interior wall extend perpendicular to the hosel axis allows the center of gravity to be placed in a more advantageous place than in the golf club head of the '903 patent.

Furthermore, the difference between the golf club defined in claim 1 and the golf club head disclosed in the '903 patent is not merely a design choice since by having the interior wall extend perpendicular to the hosel axis makes the golf club head defined in claim 1 more difficult to

manufacture than the golf club head disclosed in the '903 patent. Thus, the '903 patent is not modifiable to read on claim 1.

Moreover, prior to Applicants' disclosure there was no motivation either in the '903 patent itself, or in the art to modify the golf club head disclosed in the '903 patent to read on claim 1. Thus, any allegation by the Examiner that the '903 patent is modifiable to read on claim 1 would be an attempt to utilize impermissible hindsight in view of Applicants' disclosure (See MPEP § 2143).

Therefore, claim 1 is neither anticipated nor made obvious by the '903 patent since the '903 patent fails to teach all of the elements of claim 1. Moreover, as demonstrated, each of the elements of claim 1 is supported by Applicants' disclosure. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1.

Claims 4 and 5 either directly or indirectly depend from claim 1 and include all of the elements thereof. Therefore, Applicants submit claims 4 and 5 are neither anticipated nor made obvious by the '903 for at least the same reasons as claim 1, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 4 and 5.

-- This section left intentionally blank --

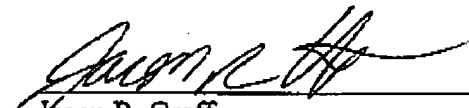
CONCLUSION

In view of the foregoing, it is believed that all claims now pending are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned.

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 11-0222 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

Date 2-17-06


Jason R. Graff
Reg. No. 54,134